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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,222	11/07/2001	Richard J. Gambino	A31982-I	3216
21003	7590	11/05/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			RESAN, STEVAN A	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,222

Applicant(s)

GAMBINO ET AL.

Examiner

Stevan A. Resan

Art Unit

1773

[Handwritten signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 17, 19-23 and 25-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 19-23 and 25-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 16, 19-22, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyman US 3985588 for the reasons of record.
3. Claims 16,17,19-23, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlin et al US 6468678 and Toliver et al US 6217252 for the reasons of record.
4. Applicant's arguments filed 7 May 2004 have been fully considered but all arguments are not persuasive.

Applicants argue against the rejection under 35 USC 102(b) based upon Lyman on the basis that in the product of Lyman the magnetized particles are concentrated in a peripheral region of the resin while the claims as amended is formed by a process of incorporating the magnetic particles by mechanofusion into a matrix material and thermally spraying the mechanofused composite particles onto a substrate in the presence of a magnetic field. Applicants assert that the article of Lyman will have a high concentration of magnetic particles near the peripheral surface and a very low concentration of magnetic particles near the inner surface with a concentration gradient of particles in between while applicants' particles would be uniformly distributed throughout the article. This is persuasive and the rejection under 35 USC 102(b) is withdrawn. However the examiner maintains the rejection under 35 USC 103.

Applicants argue against the rejection under 35 USC 103 based upon Lyman on the basis that in the process of Lyman the container is rotated thus distributing the

particles in a denser concentration in the outer regions of the article thus teaching away from a process not formed by rotation but by magnetic particles incorporated into a matrix by mechanofusion into or onto matrix material and that the particles be thermally sprayed onto a substrate.

However, applicants particles are thermally sprayed in the presence of a magnetic field and are present on the substrate in a fluid/semifluid state essential to allow the individual particles to be oriented. It is the examiner's position that the strength of the magnetic field and the fluidity of the matrix resin would allow a concentration gradient in the article thus forming a structure of the finished article similar to that of Lyman.

Applicants argue against the rejection of the claims under 35 USC 103 based upon Dahlin and Tolliver on the basis that Tolliver fails to teach or suggest incorporating the magnetic particles by mechanofusion into or onto a matrix material or thermally spraying the mechanofused composite particles onto a substrate in the presence of a magnetic field.

However applicants have not argued that the final structure of the article of Tolliver would be different from applicants article nor have a claim based upon this structure. In its simplest form (neglecting the process limitations which applicants have failed to point out a resultant patentable article structure) is a magnetic coating of a matrix resin containing oriented magnetic particles. Such a structure not only includes the articles of the present references but would also read on the magnetic coating applied to a substrate to form a magnetic recording tape.

If applicants desire to continue prosecution it is advised that they present claims directed to the structural features of the assertedly inventive article.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is 571-272-1513. The examiner can normally be reached on Tues-Thurs from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached at 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEVAN A. RESAN
PRIMARY EXAMINER